

Remarks

Summary of the Office Action

Claims 1, 3-16, and 20-31 are pending in this application.

Claims 1, 3-5, 7, 11-13, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson et al. U.S. Publication No. 2003/0110499 in view of Zigmond et al. U.S. Patent No. 6,698,020 (hereinafter "Zigmond").

Claim 6, 20, 21, 24, and 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson and Zigmud in view of Dedrick U.S. Patent No. 5,724,521 (hereinafter "Dedrick").

Claims 8 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson and Zigmond in view of Lawler U.S. Patent No. 5,758,259 (hereinafter "Lawler").

Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson and Zigmond in view of Young et al. U.S. Patent No. 5,353,121 (hereinafter "Young").

Claims 22, 23, 26, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over as being unpatentable over Knudson, Zigmond, and Dedrick in view of O'Flaherty et al. U.S. Patent No. 6,253,203 (hereinafter "O'Flaherty").

Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson and Zigmond in view of Marsh et al. U.S. Patent No. 5,848,397 (hereinafter "Marsh").

Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson, Zigmond, and Dedrick in view of Marsh.

These rejections are respectfully traversed.

Applicant's Reply to the
Rejection Under 35 U.S.C. § 103(a)

Independent claims 1, 15, 20, and 24 are rejected under 35 U.S.C. § 103(a) as being obvious from Knudson in view of Zigmond. The Examiner's rejection is respectfully traversed.

Applicant's independent claims 1, 15, 20, and 24 are, generally speaking, directed toward a method and system for targeting advertisements to television viewers that have a television receiver and a television screen that displays an electronic program guide (EPG) from EPG data stored in an EPG data base. Use of the EPG is monitored and a viewer profile is developed based on viewer usage of the EPG using the EPG data from the EPG data base. A plurality of advertisements are received by the receiver and fewer than all of those advertisements are stored on the receiver depending on the viewer profile. One or more of the stored advertisements are displayed on the television screen in the EPG.

In other words, applicant's independent claims 1, 15, 20, and 24 are, generally speaking, directed toward a system for selectively storing advertisements to be displayed in an EPG based on monitoring the viewer's usage of the EPG. Usage of the EPG, such as which programs are selected for scheduling to record, to watch, or to display more details about a program, is monitored to develop the user profile. Only those

advertisements that match the user profile are stored on the receiver and are displayed to the viewer within the EPG.

Knudson refers to a television program guide system in which targeted advertisements are presented to a user (see Knudson, abstract). Advertising information is presented to the user based on the user's interactions with the program guide that are indicative of the user's interests (see Knudson, paragraph 57).

Zigmund refers to selecting and inserting advertisements into a video programming feed (see Zigmund, abstract). During display of the video programming feed, an appropriate time for displaying a selected advertisement to the viewer is indicated by a triggering event. At the appropriate time indicated by the triggering event, the video programming feed is interrupted and the selected advertisement is displayed to the viewer (see Zigmund, col. 4, lines 36-52). The advertisements may be selected with an ad filter device that is used to pre-screen and accept only selected advertisements from the ad delivery source (see Zigmund, col. 15, lines 17-23).

The Examiner contends that Knudson shows all of the elements of applicant's independent claims 1, 15, 20, and 24 except selectively storing fewer than all of the received advertisements at the receiver depending on the viewer profile. To address these deficiencies in Knudson, the Examiner contends that it would be obvious to modify Knudson with the teachings of Zigmund.

I. THE EXAMINER HAS FAILED TO PROVIDE
MOTIVATION TO COMBINE THE REFERENCES

In order to establish a *prima facie* case of obviousness based on a combination of references, there must be

"some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

In support of the combination of Knudson with Zigmond, the Examiner states that:

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Knudson to include selectively storing fewer than all of received [sic] advertisements at a receiver depending on a viewer profile, as taught by Zigmond, for the benefit of conserving memory in the receiver. Office Action, p. 4.

Applicant respectfully submits that this is not sufficient motivation to combine Knudson with Zigmond. In particular, Knudson and Zigmond refer to two completely different types of systems for presenting targeted advertising information to the

user. As mentioned above, Knudson presents targeted advertisements within a television program guide system. In contrast, Zigmond presents advertisements by inserting them into a video program feed. Since Zigmond does not show or suggest techniques for presenting advertisements in a program guide, one skilled in the art would not have any motivation to combine the two references at all, let alone in the manner that the Examiner has suggested. Accordingly, the Examiner has not provided sufficient motivation to combine Knudson with Zigmond.

Further, the Examiner has merely listed an alleged benefit of selectively storing fewer than all of the received advertisements at the receiver instead of pointing to an objective teaching in either Knudson or Zigmond that would lead one of ordinary skill in the art to combine these references in the manner suggested by the Examiner. Namely, the Examiner has indicated that there is a benefit to selectively storing fewer than all of the received advertisements at a receiver depending on a viewer profile, but not why one of ordinary skill in the art would be motivated to combine the systems of Knudson and Zigmond to achieve this result. These two system cannot be combined in this manner without an objective teaching in either Knudson or Zigmond that would lead one of ordinary skill in the art to combine these references. Accordingly, the Examiner has not provided sufficient motivation to combine Knudson and Zigmond.

II. THE EXAMINER HAS EMPLOYED HINDSIGHT RECONSTRUCTION IN COMBINING THE REFERENCES

Applicants respectfully submit that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicants' novel system for displaying

targeted advertisements in an EPG, particular features of the prior art were identified for use in rejecting applicants' invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicants' own invention as a bridge between Knudson and Zigmond. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

Conclusion

For at least the forgoing reasons, applicants respectfully request that the rejection of amended independent claims 1, 15, 20, and 24 be withdrawn.

The remaining dependent claims all variously depend from amended independent claims 1, 15, 20, and 24 that are non-obvious over the prior art. Accordingly, applicants respectfully request that the rejection of these claims should also be withdrawn.

For at least the reasons set forth above, applicants respectfully submit that claims 1, 3-16, and 20-31 are in condition for allowance.



Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Chasan", written over a horizontal line.

Michael J. Chasan
Reg. No. 54,026
Agent for Applicant
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
Tel.: (212) 596-9000
Fax: (212) 596-9090